

## **REMARKS**

### Office action summary

Claims 29-31, 36-37, and 42-56 are pending in the present application. Claims 29, 31, 36, 43, 45, 47, 49-50, 52, 54, and 56 are presently amended. No claims are presently added or canceled. The following rejections were made in the office action of June 10, 2009 (“Office Action”):

- Claims 45, 49, and 56 were rejected under 35 USC § 112, ¶ 1, as failing to comply with the written description requirement.
- Claims 29-31, 36-37, 43-45, 47-52, and 54-56 were rejected under 35 USC § 102(b) as being anticipated by Nagasaka, US Patent 5,333,246 (“Nagasaka”).
- Claims 42, 46, and 53 were rejected under 35 USC § 103(a) as being unpatentable over Nagasaka in view of Kito, US Patent 6,628,899 (“Kito”).

The amendments and rejections are discussed below. The examiner is respectfully urged to reconsider the application and withdraw the rejections. Should the examiner have any questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants’ undersigned attorney, Jon M. Isaacson, at **206-332-1102**.

### Telephonic interview

On August 17, 2009, applicants’ undersigned attorney, Examiner Nguyen, and Examiner Poon conducted a telephonic interview. Applicants’ undersigned attorney would like to thank the examiners for granting the interview. During the interview, the rejection under 112 was discussed without reaching an agreement. Further, proposed amendments to claims 29, 36, and 50 were discussed in light of the rejections under 35 USC § 102(b); the examiners agreed that the proposed amendments overcome the cited art of record. Any further substance of the interview is incorporated into the remarks below.

### Rejections under 35 USC § 112

Claims 45, 49, and 56 stand rejected under 35 USC § 112, ¶ 1, as failing to comply with the written description requirement. Specifically, the examiner found that the

specification teaches reducing the time to process all of the images, but not reducing the time to process a portion of the images. (See Office Action, page 3.) Without conceding the propriety of the rejection, in an effort to advance prosecution of the present application, applicants presently amend claims 45 to recite, in full:

The method of claim 29, wherein the performing image processing comprises performing image processing such that the time required to print the first plurality of processed images is less than the time required to print the digital images in the subset; whereby the time required to print the first plurality of processed images and the digital images from the plurality of digital images not in the subset is less than the time required to print the plurality of digital images.

During the telephonic interview, the examiners expressed concern that neither claim 45, nor claim 29, recites printing the full plurality of digital images. However, such a step is not required by the teachings of applicants' disclosure. More specifically, applicants' disclosure indicates that "[an] image processing unit 126...process[es] selected images 124 so as to reduce the total print time." (Specification, page 21, lines 10-17.) Applicants submit that the disclosure clearly supports processing a portion of the images so as to reduce the overall print time of all the images, without requiring that the entire set of images actually be printed. Thus, applicants submit that the present amendments to claim 45, indicating that the total time to print the plurality of digital images is reduced by performing image processing on a subset of those images, is supported by the specification. Similar amendments are presently made to claims 49 and 56. For at least these reasons, applicants submit that claims 45, 49, and 56 comply with 35 USC § 112, ¶ 1, and applicants respectfully request withdrawal of the rejection of claims 45, 49, and 56 under 35 USC § 112, ¶ 1.

Rejections under 35 USC §§ 102(b) and 103(a)

Claim 29 stands rejected under 35 USC § 102(b) as being anticipated by Nagasaki. Without conceding the propriety of the rejection of claim 29, in an effort to advance prosecution of the present case, applicants presently amend claim 29 to recite, in part:

determining a subset of the plurality of digital images which require image processing to meet an image parameter, the subset including fewer than all of the plurality of digital images;

performing image processing on the digital images in the subset to produce a first plurality of processed images;

Applicants submit that the cited portions of Nagasaka fail to teach the recited image parameter of claim 29. Further, applicants can discern no teaching in the cited portions of Nagasaka which teach determining a subset of a plurality of digital images which require image processing to meet a defined image parameter, or performing image processing on the digital images in the subset. Thus, applicants submit that claim 29 is patentably defined over the cited art. Accordingly applicants respectfully request withdrawal of the rejection of claim 29 under 35 USC § 102(b).

Independent claims 36 and 50 are presently amended such that they contain recitations similar to those recitations of claim 29 discussed above. For at least the reasons discussed above regarding the patentability of claim 29, applicants submit that claims 36 and 50 are patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claims 36 and 50 under 35 USC § 102(b).

Claims 30-31, 37, 42-49, and 51-56 depend, directly or indirectly, from claims 29, 36, and 50. Inasmuch as claims 30-31, 37, 42-49, and 51-56 depend from independent claims which are patentably defined over the cited art, applicants submit that claims 30-31, 37, 42-49, and 51-56 are patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claims 30-31, 37, 42-49, and 51-56 under 35 USC §§ 102(b) and 103(a).

#### Conclusion

Applicants believe that the present remarks are responsive to each of the points raised by the examiner in the Office Action, and submit that claims 29-31, 36-37, and 42-56 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the examiner's earliest convenience is earnestly solicited.

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